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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,818	02/24/2000	Scott Harvey Demsky	AUS990886USI	7815

7590

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EXAMINER

BROWN, TIMOTHY M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/513,818

Applicant(s)

DEMSKY ET AL.

Examiner

Tim Brown

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/24/00.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. Claims 1-14 have been examined.

#### ***Claim Objections***

2. Claim 3 is objected to for containing a minor informality in that line 11 recites "the client" while claim 2 refers to "the buyer" in line 28. This error is repeated in lines 20 and 21 of claim 4. Appropriate correction is required.
3. Claim 10 is objected to for containing a minor informality in that line 26 recites "the client" while claim 9 refers to "the buyer" in line 14. This error is repeated in lines 3 and 4 of claim 11. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4, 8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 4 recites the limitation "the representation for the desired item" in lines 22 and 23. There is insufficient antecedent basis for this limitation in the claim. This error is repeated in lines 6 and 7 of claim 11
7. Claim 8 recites the limitation "the plurality of selectable states" in line 28. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-3, 5-10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (US 5,966,697) in view of Walker et al. (US 5,794,207).**

Regarding claim 1, Ferguson et al. teach a method for carrying out, over a communication network of interconnecting computers, electronic transactions between a plurality of merchants using at least one server computer and at least one buyer using a client computer, comprising:

displaying, at the client computer, a separate representation for each item selected by the buyer from at least two different merchants (col. 2, lines 32-36; col. 8, lines 29-34; col. 13, lines 60-67; and Figs. 9A and 9F); and

associating one of a plurality of selectable states with each separate representation (col. 2, lines 38-41; and col. 9, lines 42-46).

Ferguson et al. do not specifically teach having one of the plurality of selectable states indicate that the buyer desires to purchase a desired item from a first merchant if a previous transaction which bought another item from a second merchant can be canceled. However, Walker et al. teach communicating, over a network, a conditional purchase offer wherein the conditional purchase offer contains conditions that must

occur before an acceptance can take place (Abstract; and col. 8, lines 42-56). At the time of the applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Ferguson et al. to include the teachings of Walker et al. because having one of the plurality of selectable states indicate that the buyer desires to purchase a desired item from a first merchant if a previous transaction which bought another item from a second merchant can be canceled would enable a user to condition buying an alternate good on the user's ability to cancel the purchase of a previously selected good. Thus, a user could substitute a previously-purchased good, with a more desirable good without being liable for two transactions.

Regarding claim 2, Ferguson et al. teach a method for carrying out, over a communication network of interconnecting computers, electronic transactions between a plurality of merchants using at least one server computer and at least one buyer using a client computer, comprising:

enabling the client computer to display a separate representation for each item selected by the buyer from at least two different merchants wherein each representation has one of a plurality of associated states at a given instance in time (col. 2, lines 32-36; col. 8, lines 29-34; col. 13, lines 60-67; and Figs. 9A and 9F); and

selecting, by the buyer, a desired item from a certain merchant with a selected associated state (col. 2, lines 22-26; and col. 8, lines 1-21).

Ferguson et al. do not specifically teach communicating to the certain merchant, a condition indicating that the buyer desires to purchase the desired item if a previous transaction which bought another item from another merchant can be canceled.

However, Walker et al. teach communicating, over a network, a conditional purchase offer wherein the conditional purchase offer contains conditions that must occur before an acceptance can take place (Abstract; and col. 8, lines 42-56). At the time of the applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Ferguson et al. to include the teachings of Walker et al. because communicating to the certain merchant, a condition indicating that the buyer desires to purchase the desired item if a previous transaction which bought another item from another merchant can be canceled would enable a user to condition buying an alternate good on the user's ability to cancel the purchase of a previously selected good. Thus, a user could substitute a previously-purchased good, with a more desirable good without being liable for two transactions.

Regarding claim 3, Ferguson et al. teach sending, from the client, to the certain merchant an identification of the other merchant and the other item, and receiving a notification that the previous transaction is canceled (col. 2, lines 31-41).

Regarding claim 5, changing the selected state to a different state, upon notification of the cancellation, wherein the different state provides an indication of one of the following: a) the buyer desires to put the desired item on hold for a time to consider buying the desired item, and b) the buyer has bought the desired item (col. 11, lines 30-34).

Regarding claim 6, Ferguson et al. inherently teach providing the other item with another representation wherein the associated state is changed, upon receipt of the notification, to indicate that the previous transaction is canceled. Ferguson et al.

disclose that a user's order is displayed both before and after a user has deleted unwanted items from the order list (col. 9, lines 42-46; and col. 10, lines 1-13).

Therefore, the cancellation of a previously ordered item is indicated by its absence in the modified order list. As a result, Ferguson et al. inherently teach providing the other item with an other representation wherein the associated state is changed, upon receipt of the notification, to indicate that the previous transaction is canceled.

Regarding claim 7, Ferguson et al. teach providing the other item with a displayed other representation on the client computer which becomes automatically deleted, upon receipt of the notification indicating that the previous transaction is canceled (col. 9, lines 42-46; and col. 10, lines 1-13).

Claim 8 is rejected as discussed under claim 1 above as claim 8 pertains to a computer system for carrying out the method of claim 1.

Regarding claim 9, Ferguson et al. teach a client computer system enabled to communicate over a network with at least one server computer system for carrying out electronic transactions for a buyer using the client computer system for the purchase of items from a plurality of merchants using the at least one server computer system, the client computer system comprising:

means for displaying a separate representation for each item selected by the buyer from at least two different merchants wherein each representation has one of a plurality of associated states at a given instance in time (col. 2, lines 32-36; col. 8, lines 29-34; and col. 13, lines 60-67); and

means for selecting, by the buyer, a desired item from a certain merchant with a selected associated state indicating that the buyer desires to purchase the desired item (col. 2, lines 22-26; and col. 8, lines 1-21).

Ferguson et al. do not specifically teach a means for conditioning the selection of a desired item on if a previous transaction which bought another item from another merchant can be canceled. However, Walker et al. teach communicating, over a network, a conditional purchase offer wherein the conditional purchase offer contains conditions that must occur before an acceptance can take place (Abstract; and col. 8, lines 42-56). At the time of the applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Ferguson et al. to include the teachings of Walker et al. because a means for conditioning the selection of a desired item on if a previous transaction which bought another item from another merchant can be canceled would enable a user to condition buying an alternate good on the user's ability to cancel the purchase of a previously selected good. Thus, a user could substitute a previously purchased good, with a more desirable good without being liable for two transactions.

Regarding claim 10, Ferguson et al. teach a means for sending, from the client, to the certain merchant an identification of the other merchant and the other item, and means for receiving a notification that the previous transaction is canceled (col. 2, lines 31-41).

Regarding claim 12, Ferguson et al. teach a means for changing the selected state to a different state, upon notification of the cancellation, wherein the different state provides an indication of one of the following: a) the buyer desires to put the desired



item on hold for a time to consider buying the desired item, and b) the buyer has bought the desired item (col. 11, lines 30-34).

Claim 13 is rejected as discussed under claim 1 above as claim 13 pertains to a computer program for accomplishing the method of claim 1.

Claim 14 is rejected as discussed under claim 9 above as claim 9 pertains to a computer program for use in the system of claim 9.

**10. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (US 5,966,697) in view of Walker et al. (US 5,794,207) and a second patent issued to Walker et al. (US 6,249,772) ('772).**

Regarding claim 4, Ferguson et al. and Walker et al. teach all the limitations discussed under claim 1 above. Ferguson et al. and Walker et al. do not specifically teach a method for carrying out electronic transactions between a plurality of merchants and at least one buyer wherein the selected associated state causes an indication to be sent from the client to the certain merchant to lock specific data associated with the desired item from being accessible by a different client during a period that the representation for the desired item has the selected associated state. However, '773 discloses reserving an item at a local store after a user has negotiated a price for the item over a communication network (col. 10, lines 35-64). At the time of the applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Ferguson et al. and Walker et al. to include the teachings of '773 because a method for carrying out electronic transactions between a plurality of merchants and at least one buyer wherein the selected associated state causes an indication to be sent from the

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client to the certain merchant to lock specific data associated with the desired item from being accessible by a different client during a period that the representation for the desired item has the selected associated state would enable a merchant to hold an item for a buyer so that the item will not be sold while the buyer decides whether to purchase the item.

Claim 11 is rejected as discussed under claim 4 above as claim 11 pertains to a system for accomplishing the method of claim 4.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Micali (US 5,615,269) 25 March 1997; a method for accomplishing an electronic transaction wherein a buyer and seller communicate with respect to a selling reservation price and a buying reservation price
- b. Walker et al. (US 6,256,878) 12 March 2002; a conditional purchase offer system for processing variable conditional purchase offers containing at least one variable condition
- c. Jacobi et al. (US 6,317,722) 13 November 2001; a computerized system for recommending items to a user based upon the a set of items observed in a virtual shopping cart
- d. Keller et al. (US 6,304,850) 16 October 2001; a method for purchasing an airline ticket comprising the steps of entering, by a consumer, a target price for a

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selected flight and performing a search of at least one airline reservation database

- e. "Yahoo! Delivers a One-Stop Internet Shopping Service Featuring More Than 2 Million Products," PR Newswire (November 17, 1998)
- f. "PDG Launches Shopping Mall," Washington Business Journal, Vol. 18, no. 24 (October 22, 1999) p. 20
- g. "Acses' 'Comparison Shopping Car' Makes Comparison Shopping Online Easier Than Ever Before," Business Wire (November 17, 1998)
- h. "Comparison Shopping Made Easy," PR Newswire (October 26, 1998)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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Tim Brown  
Examiner  
Art Unit 3625

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June 21, 2002



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